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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,851	09/26/2003	Colin Andrew Low	30018433-3	1268

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHENG, JOE H

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/672,851

Applicant(s)

LOW ET AL.

Examiner

Joe H. Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In response to the Amendment filed on January 23, 2007, claims 1-11 are pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all the claimed method steps, *inter alia*, simulating activities of the plurality of creatures at a first mode of simulation, simulating an activity of one of the plurality of creatures at the second mode of simulation, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

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3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation of the first mode of the simulation is less detailed and less computationally intensive than a second mode of simulation and wherein results of the simulation at the second mode of simulation are used to provide a simulation of the plurality of creatures at the first mode of simulation, are not adequately supported by the originally filed specification and drawings. No disclosure concerning the aforementioned structural limitation is provided. See MPEP 608.04(b).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The references for “the first mode of the simulation is less detailed and less computationally intensive than a second mode of simulation” and “wherein results of the simulation at the second mode of simulation are used to provide a simulation of the plurality of creatures at the first mode of simulation” (as per claims 1, 10 and 11) are unclear. In addition, it

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appeared that applicant is intended to claimed the Markush groups, *inter alia*, fighting, mating, eating (as per claim 3), creature mass, creature energy, creature strength (as per claims 7-9) is improper. It is suggested that when materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner or alternatively, for example, “wherein ... is ... selected from the group consisting of ... and ...” or “wherein ... is ... or ...” is a proper limitation and is considered proper. See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925) and MPEP § 2173.05(h)). Further, the antecedent basis for “the method changes from utilizing the second mode to the first mode” (regarding to claim 6) has not been clearly set forth. Furthermore, regarding to claim 11, the recitation therein is confusing and unclear, because the second mode of simulation arranged is missing. Specifically, the term “two mode of simulation: **a first mode arranged to:**” (line 3 of claim 11) is confusing and unclear.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. To satisfy the section 101 requirements, the claim must be for a practical application of the 101 judicial exception, which can be identified by either (a) the claimed invention “transforms” an article or physical object to a different state or thing or (b) the invention otherwise produces a useful, concrete and tangible result. The method is directed to a computerized simulation of the activities of the creatures process. In order for a claim to be

statutory it must show a practical application. In the present case there is no physical transformation occurring, each of the steps is intended to occur with the aid of a computer system. The claims, therefore, do not meet the first of the requirements. The claims fail to always produce a **tangible result**. In order for the result to be tangible, it must be a “real-world” result. In other words, a user of the system must be capable of appreciating the result of the method. This can be achieved through any form of communicating the result to the user, which gives it a real world value. Further, Claims 10 is directed to the computer readable medium having recorded thereon computer readable code and do not require a transformation any physical subject matter, tangible or intangible, into a different state or thing. The claim is drawn simply to the computer software (i.e. software application), which is merely a set of instructions capable of being executed by a computer when the computer software is run on a computer for simulating the activities of a plurality of creatures. It is noted that claims to the computer program/software *per se* are not a process and without the computer-readable medium needed to realize the computer program/software’s functionality are nonstatutory functional descriptive material. See MPEP 2106 IV B 1(a). Specifically, a claim to a tangible computer-readable medium encoded with a computer program/software is statutory because it is a computer element, which defines structural and functional interrelationships between the computer program and other component of a computer, which permits the computer program/software’s functionality to be realized.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-11 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by “The Sims Livin’Large Expansion Pack – Prima’s Official Strategy Guide” by Rick Barba, 2000 (hereinafter as Barba) for the reasons set forth in the prior Office action and incorporated herein. Applicant is informed that the newly added unsupported limitation of the first mode of the simulation is less detailed and less computationally intensive than a second mode of simulation and wherein results of the simulation at the second mode of simulation are used to provide a simulation of the plurality of creatures at the first mode of simulation are not considered in the rejection. Hence, all the claimed limitations are rejected for the same reasons set forth in the prior Office action.

Conclusion

Response to Arguments

11. Applicant's arguments with respect to claims 1-11 have been fully considered but they are not deemed to be persuasive. Applicant's arguments directed to the newly added unsupported limitation of the first mode of the simulation is less detailed and less computationally intensive than a second mode of simulation and wherein results of the simulation at the second mode of simulation are used to provide a simulation of the plurality of creatures at the first mode of simulation, which are withdrawn from consideration by the Examiner. Hence, applicant's argument is not deemed to be persuasive and the rejection under 35 U.S.C. §102(b) is proper and

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stands. In addition, applicant's amendment with respect to claims 1-11 are also moot in view of the new ground(s) of rejection.

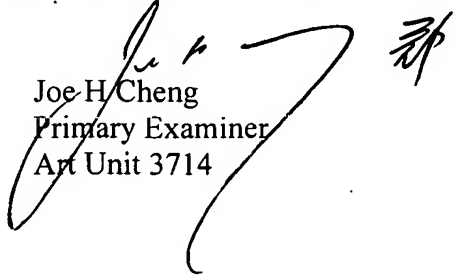
12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (571) 272-4433. The examiner can normally be reached on Tue. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joe H. Cheng
Primary Examiner
Art Unit 3714

Joe H. Cheng
April 13, 2007